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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,009	12/04/2001	Bob van Gemen	5189US	7686

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EXAMINER

WHISENANT, ETHAN C

ART UNIT PAPER NUMBER

1634

DATE MAILED: 08/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

10/006,009

Applicant(s)

VAN GEMEN ET AL.

Examiner

Ethan Whisenant, Ph.D.

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2002 and 10 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-25 and 47-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-25 and 47-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1634

DETAILED ACTION

1. Applicant's election of Group I (Claims 1-14 and 30-35) without traverse in the paper filed 03 DEC 02 is acknowledged. Claims 15-29 and 36-46 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. The restriction requirement has been reconsidered, is deemed proper and is therefore, herein made **FINAL**. In addition, it is noted that the claims withdrawn above (i.e. Claims 15-29 and 36-46) were canceled in the paper filed 03 DEC 02. The applicant then, in a Supplemental response to the restriction requirement [i.e. the paper filed 10 DEC 02], indicated that an error had been made in the paper filed 03 DEC 02 and that it not be entered. Instead the applicant requested that Claims 1-16 and 26-46 be canceled and Claims 17-25 and 47-52 as presented in the paper(s) filed 10 DEC 02 be examined. It is noted that Claims 17-18 are as originally filed and Claims 19-25 are as amended in the preliminary amendment filed 04 DEC 01 and Claims 47-52 are new claims present in the paper(s) filed 10 DEC 02. An action on **Claims 17-25 and 47-52** follows.

DRAWINGS

2. The drawings filed 12 APR 02 as substitute drawings are unacceptable. Note that the illegible, heavily shaded portions of Figures 1-11, see for example US 2002/0164612 A1 (i.e. the US Patent Application Publication for the instant application). **Please correct.**

SEQUENCE RULES

3. This application complies with the sequence rules and the sequences have been entered by the Scientific and Technical Information Center.

INFORMATION DISCLOSURE STATEMENT

4. The information disclosure statement filed 08 MAR 03 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. Please provide a **corrected IDS**, , which list all patents and publications the applicant wishes considered by the office.

35 USC § 112- 2ND PARAGRAPH

- 5.** The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

CLAIM REJECTIONS UNDER 35 USC § 112- 2ND PARAGRAPH

- 6.** **Claim(s) 17-25 and 47-52** is/are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 is indefinite because it is unclear if the second nucleic acid and/or gene product thereof must be from a endosymbiont cellular organelle or if the second nucleic acid and/or gene product thereof may be any second nucleic acid and/or gene product from the organism. **Please clarify.**

Please note that the claim has been interpreted broadly meaning that the examiner has interpreted the ambiguous language above as if the second nucleic acid and/or gene product thereof may be any second nucleic acid and/or gene product from the organism.

Claim 52 is indefinite because it is not clear what is meant by the phrase "mononuclear cell" on line 3.

ALLOWABLE SUBJECT MATTER

- 7.** **Claim(s) 17-25 and 47-52** would appear to be allowable over the prior art of record. The prior art considered does not teach or reasonably suggest the method for determining therapeutic activity and/or possible side-effects of a medicament as recited in Claim 17.

Art Unit: 1634

CONCLUSION

8. Claim(s) 17-25 and 47-52 is/are rejected and/or objected to for the reason(s) set forth above.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ethan Whisenant, Ph.D. whose telephone number is (703) 308-6567. The examiner can normally be reached Monday-Friday from 8:30AM -5:30PM EST or any time via voice mail. If repeated attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152.

The fax number for this Examiner is (703) 746-8465. Before faxing any papers please inform the examiner to avoid lost papers. Please note that the faxing of papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989). Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-0196.



**ETHAN WHISENANT
PRIMARY EXAMINER**